

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. MISTOPOULOS
and THOMAS L. GUSTAFSON

Appeal No. 2002-1847
Application 09/478,393

ON BRIEF

Before WARREN, OWENS and MOORE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 29 through 31 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Gustafson et al. ‘345 or ‘427 in view of Gross, and of appealed claims 32, 33 and 35 through 43¹ under 35 U.S.C. § 103(a) as being unpatentable over Gustafson et al. ‘345 or ‘427.²

¹ See the amendment of September 14, 2000 (Paper No. 6). Claims 15 through 28 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

² Answer, pages 3-8.

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

Contrary to appellants' characterization of the manner in which the encapsulated electroluminescent (EL) light strip is formed in the Gustafson references³ (brief, e.g., pages 5-6 and 8), we find that one of ordinary skill in this art would have found in these references the teachings and inferences⁴ that the method of encapsulation of the EL light strip by extrusion with "polymeric materials such as Surlyn®, an ionomer resin, high density polyethylene, or polychlorotrifluoroethylene" as well as polyvinylchloride, would result in a continuous, seamless coating of the strip by the polymeric material (*see* Gustafson, '427, e.g., col. 4, lines 9-19 and 47-60, and Figs. 2 and 7). Indeed, appellants employ the same materials (specification, page 7, lines 7-9) in "extruder station 64 [that] consists of a configuration of extruders, of the type well known in the art, for extruding the thermoplastic housing over the circuit assembly, dies and

³ We note that the lineage of both of the Gustafson references begins with application 07/668,862, and the basic difference between the two is that Gustafson '427 has several more embodiments.

⁴ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

additional extrusion related components” (*id.*, page 10, line 21, to page 11, line 2).

Thus, we agree with the examiner that the differences between the claimed method encompassed by the appealed claims and the Gustafson references are as follows: (1) appealed claim 29 – the method of the Gustafson references encapsulates an EL light strip instead of a light emitting diode (LED)light strip; (2) appealed claim 31 – the method of the Gustafson references encapsulates an EL light strip that has an “aluminum foil base electrode **22**” (e.g., Gustafson ‘345, lines 10-12, and Fig. **2**) instead of an LED light strip affixed to a substrate made of the same thermoplastic material that is continuously extruded; and (3) appealed claim 32 –the method of the Gustafson references encapsulates an EL light strip that has an “aluminum foil base electrode **22**” (e.g., Gustafson ‘345, col. 3, lines 10-12, and Fig. **2**) instead of any “continuous length of assembled light circuits affixed to a thermoplastic substrate.”

With respect to the first difference, the examiner relies on Gross, which would have disclosed an LED light strip covered with “a U-shaped protective translucent plastic cover **56**,” for use in “confined areas,” e.g., embedding the light strip in carpeting or other covering in a hall way, but does not disclose the method for making the LED strip or materials of which it is made (cols. 1-3 and FIGs. **1-5**). The examiner posits that one of ordinary skill in this art would have substituted the LED light strips of Gross for the EL light strips in the Gustafson method for protection from moisture and the cracking of plastic cover **56** (answer, page 7). We must agree with appellants that, on this record, the disclosures of the Gustafson references and Gross, separately or combined, would not have provided one of ordinary in the art with the motivation to encapsulate the LED strip of Gross by the method of Gustafson. Thus, we conclude that the examiner has not pointed to some teaching, suggestion or motivation in the prior art to combine these references. *See Lee, supra; Smith Industries medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999); *In re Mayne*, 1043 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997); *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783; *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 9292, 933 (Fed. Cir. 1984); *In re Keller*, 642 F.2d 413, 425-26, 208 USPQ 871, 881-82 (CCPA 1981). Indeed, the fact that the LED strip of Gross could be encapsulated by the method disclosed by Gustafson does not alone provide the basis for combining the applied prior art. *See, e.g., In re Fritch*,

972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”).

With respect to the second and third differences noted above, we agree with appellants that there is no structure associated with an EL light strip of Gustafson which can be said to be a substrate of the same thermoplastic material used to encapsulate the strip, including the substrate. While the examiner points to the bonding of an EL light strip to body **218** in Gustafson Fig. **5** (answer, pages 5-7), we find that Gustafson ‘345 discloses that EL lamp **220** is already encapsulated by extrudate **236**, and it is the encapsulated EL strip that it bonded to body **218** to provide strip **210** (col. 3, line 65, to col. 4, line 3). The examiner does not provide any evidence in support of his contentions with respect to the practices in the art with respect to the use of thermoplastic substrates, and thus has failed to establish that one of ordinary skill in the art would have modified the EL laminate light strip taught in Gustafson by attaching the same to a thermoplastic substrate prior to encapsulation. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”).

Accordingly, the examiner has failed to establish a *prima facie* case of obviousness with respect to either of the grounds of rejection, and thus we reverse both grounds.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

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